

Appln. No. 10/520,008
Amd. dated March 10, 2010
Reply to Office Action of September 30, 2009

REMARKS

The Office Action and the cited and applied references have been carefully reviewed. No claim is allowed. Claims 3, 4, 7-10, 17-21 and 24-27 presently appear in this application and define patentable subject matter warranting their allowance. Reconsideration and allowance are hereby respectfully solicited.

Claims 17 and 18 are amended to recite for a double-stranded DNA and for the DNA in step (2) to be transferred into a cell without denaturation (i.e., remains double-stranded), as supported in the present specification at page 26, lines 18-20. This amendment makes it clear that the DNA prepared is a double-stranded DNA which is not denatured to a single-stranded DNA upon transfer into a cell.

Claims 3-10 and 17-27 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The examiner states that the original claims have a "comprising" language, and as such, necessarily does not demonstrate or convey that the invention is to exclude all other sequences. The examiner requires applicant to re-introduce the "comprising" language, as used before, to overcome this rejection because the use of "having"

instead of "consisting of" will not do and because one of skill in the art would not have understood the invention to be to the exclusion of other sequences. This rejection is respectfully traversed.

The examiner is apparently taking the position that by changing the claim language from "comprising" to "consisting of," the claim is no longer supported by the written description. However, this position is untenable. A "comprising" claim includes all of the specifically enumerated species, but is open to include other non-enumerated species. A "consisting of" claim reads only on the specifically enumerated species, but is not open to the addition of other non-enumerated species. Thus, in the simplest situation, a claim "comprising A+B" certainly discloses A+B but is open to the possibility of other ingredients. Changing that claim to "consisting of A+B" does not add new matter as the claim always explicitly included at least A+B. The same is the situation here. If there is written description support for the minimum plus unidentified other things, then there must also be written description support for the minimum. This logic is supported by cases, such as in *In re Wertheim*, 541 F2d 257, 191 USPQ 90 (CCPA 1976), which essentially held that

there is support for the bottom number of a range. A "comprising" claim is akin to an open-ended range. Changing it to "consisting of" limits it to the minimum number in the range. *Wertheim* finds that to be acceptable. See also in *In re Johnson*, 558 F2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977). Merely deleting unenumerated possible additional sequences or elements does not mean that the specification lacks description for the part remaining that was specifically described in the claim. The examiner is challenged to find a case that holds that changing a claim from "comprising" to "consisting of" can possibly result in a lack of written description for the remainder.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 17 and 23-27 have been rejected under 35 U.S.C. §102(b) as being anticipated by Ohshima et al., US 5,643,762. This rejection is respectfully traversed.

Ohshima only discloses a single-stranded DNA which has a stem-loop conformation (e.g., hairpin DNA). Furthermore, Ohshima teaches that the synthesis of the single-stranded DNA that forms the stem-loop structure is initiated at the "origin of replication" (see column 2, line 48 to

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column 3, line 6, and Figs. 5A and 5B). Therefore, the above stem-loop (hairpin) DNA of Ohshima is not produced from the double-stranded DNA prepared according to the presently claimed method. Accordingly, Ohshima neither anticipates nor makes obvious the presently claims invention.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 3-10 and 17-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ohshima in view of Wengel et al. (WO 99/14226), Dean et al. (US 6,130,207) and Bissler et al. (Frontiers in Biosciences 3:d408-418, 1998). This rejection is respectfully traversed.

The applied Ohshima reference is discussed above in the preceding anticipation rejection. The secondary references, Wengel, Dean and Bissler, in combination with the primary Ohshima reference do not satisfy the deficiency noted above for the Ohshima reference, and accordingly, the combination of references relied upon by the examiner cannot make obvious the presently claimed invention.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

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In view of the above, the claims comply with 35
U.S.C. §112 and define patentable subject matter warranting
their allowance. Favorable consideration and early allowance
are earnestly urged.

Respectfully submitted,

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